



PATENT
Customer No. 22,852
Attorney Docket No. 7707.0019-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Alan H. ANDERSON, et al.) Group Art Unit: 3644
)
Application No.: 10/712,042) Examiner: DINH, TIEN QUANG
)
Filed: November 14, 2003)
) Confirmation No.: 7524
For: ONE-PIECE CLOSED-SHAPE)
STRUCTURE AND METHOD OF)
FORMING SAME)
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

SUPPLEMENTAL RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement dated November 29, 2006, the Examiner required
restriction under 35 U.S.C. § 121 between the following species:

- Species A referring to Figure 12;
- Species B referring to Figure 13;
- Species C referring to Figure 15;
- Species D referring to Figure 17;
- Species E referring to Figure 9;
- Species F referring to Figure 49; and
- Species G referring to Figure 54.

The Examiner required Applicants to choose (1) between Species A and B; (2) between
Species C and D; and (3) between Species E, F, and G. The Examiner indicated that in

his opinion the species are patentably distinct. In addition, the Examiner indicated that no claims appear to be generic.

On December 28, 2006, the Applicants filed a response to the restriction requirement, traversing all the restriction requirements, and provisionally electing to prosecute species E. On March 22, 2007, the Examiner issued a notice that Applicant's reply was not fully responsive, because Applicants did not elect one of Species A and B and one of Species C and D. Therefore, Applicants are filing the present supplemental response in which Applicants again respectfully traverse the Examiner's restriction requirement.

As an initial matter, Applicants note that in the Office Action the Examiner indicates that claims 15-60 are pending. But Applicants previously canceled claims 29, 31-44, and 59 as well as claims 1-14 in the preliminary amendment filed November 13, 2006. Therefore, only claims 15-28, 30, and 45-58 are pending in this application. Thus, to the extent that the Examiner's restriction requirement is based on the inclusion of claims 29, 31-44, and 59, Applicants respectfully assert that this is in error and should be withdrawn.

Species A and B

Applicants respectfully assert that the restriction between Species A and B (Figures 12 and 13) is improper. The Examiner concludes that Figures 12 and 13 are "patentably distinct," but the Examiner has not provided any basis for this conclusion. The MPEP requires that:

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of

conclusion is inadequate. The reasons upon which the conclusion is based should be given.

MPEP § 808.01. Because the Examiner has provided only a conclusion as to the alleged distinctness and has not provided any reasons for this conclusion, the restriction requirement is improper. Moreover, Applicant cannot properly respond to the Examiner's restriction requirement absent an explanation as to why the Examiner believes the species are patentably distinct.

Applicants assume the Examiner has required restriction in this instance because Figure 12 illustrates an embodiment of the invention using a mandrel with a tail cone, while Figure 13 illustrates another embodiment of the invention using a mandrel without a tail cone.¹ None of the pending claims, however, include any limitation with respect to the structure of the mandrel. Thus, to the extent that Figures 12 and 13 illustrates separate species (which Applicants do not concede), their distinctness is irrelevant to the pending claims because all the pending claims would read on a system using a mandrel with or without a tail cone.

Should the Examiner not withdraw this restriction requirement or provide further explanation as to its basis, Applicants provisionally elect to prosecute Species A. Applicants believe claims 15-28, 30, and 45-58 correspond to Species A.

Species C and D

Applicants also respectfully assert that the Examiner's requirement that Applicants elect between Species C and D (Figures 15 and 17) is improper. Again, the

¹ If the Examiner's restriction between Species A and B rests on different grounds, Applicants respectfully request clarification as to the exact basis for restriction between Figures 12 and 13.

Examiner has not provided any explanation for why he believes these species are distinct as required by the MPEP. MPEP § 808.01. For this reason alone, restriction is improper. Moreover, Applicants are unable to determine the basis for restriction without further explanation. Both Figures 15 and 17 illustrate embodiments of the invention using a mandrel without a tail cone at different stages of the manufacturing process. Therefore, Applicants do not understand on what grounds the Examiner has required restriction. Thus, Applicants respectfully request that the Examiner either withdraw the restriction or provide the reasoning for requiring restriction as required by the MPEP.

Should the Examiner not withdraw this restriction requirement or provide further explanation as to its basis, Applicants provisionally elect to prosecute Species C. Applicants believe claims 15-28, 30, and 45-58 correspond to Species C.

Species E, F, and G

Applicants also respectfully assert that the restriction between Species E, F, and G (Figures 9, 49, and 54) is improper. Once again, the Examiner did not provide any explanation for why he believes these species are distinct as required by the MPEP. MPEP § 808.01. This alone renders the restriction requirement improper.

Applicants assume that the Examiner has required restriction between Figures 9 and 49 because Figure 9 illustrates a manufacturing process in accordance with one embodiment of the invention while Figure 49 illustrates a manufacturing process in accordance with another embodiment of the invention. As explained in the specification, however, these processes are “substantially similar” and differ primarily in the method of curing the structure. (Specification at ¶¶ [241]-[242].) Specifically, the second embodiment uses an autoclave for curing. *Id.*

In order to show that related product or process inventions are distinct, the Examiner must demonstrate that “(A) the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; (B) the inventions as claimed are not obvious variants; and (C) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect.” MPEP § 806.05(J). “The burden is on the examiner to provide an example to support the determination that the inventions are distinct . . .” *Id.* The Examiner has not provided any examples or reasoning demonstrating that any of these requirements are met. Thus, restriction between Figures 9 and 49 is improper.

Moreover, for a restriction requirement, there must be a serious burden on the Examiner to examine the claims in one application in order for restriction to be appropriate. MPEP § 803. In order to establish that a serious burden exists, the Examiner must demonstrate (a) separate classification; (b) separate status in the art; or (c) a different field of search. MPEP § 808.02 In the restriction requirement, however, the Examiner has not demonstrated any of these requirements, and thus, has not established a significant burden. Therefore, for these reasons, Applicant respectfully requests that the Examiner withdraw the restriction requirement between Figures 9 and 49.

Finally, it is unclear why the Examiner has required restriction of Figure 54. That figure illustrates a fuselage manufactured according to the process of Figure 49. None of the pending claims, however, are directed to a fuselage. Therefore, Applicants request that the Examiner provide the basis for restriction based on Figure 54.

Should the Examiner not withdraw the restriction requirement or provide further explanation as to its basis, Applicants provisionally elect to prosecute Species E.

Applicants believe claims 15-26, 28, 30, 45-56, 58 and 60 correspond to Species E.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 17, 2007

By: 

D. Brian Kacedon
Reg. No. 46,814